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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/554,146	10/24/2005	Kazuya Sakata	1034232-000040	3252
21839	7590	08/26/2008	EXAMINER	
BUCHANAN, INGERSOLL & ROONEY PC			LE, HOA VAN	
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ALEXANDRIA, VA 22313-1404			ART UNIT	PAPER NUMBER
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			08/26/2008	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ADIPFDD@bipc.com

Office Action Summary	Application No.	Applicant(s)	
	10/554,146	SAKATA ET AL.	
	Examiner	Art Unit	
	Hoa V. Le	1795	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 01 July 2008.
 2a) This action is **FINAL**. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-6 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 1-6 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
 3) Information Disclosure Statement(s) (PTO/SB/08)
 Paper No(s)/Mail Date 04/16/08.

4) Interview Summary (PTO-413)
 Paper No(s)/Mail Date. _____.
 5) Notice of Informal Patent Application
 6) Other: _____.

This is in response to Papers filed on 07/01/08.

I. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 and 3-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Iwa et al (2002/0076637).

Iwa et al disclose, teach and suggest a binder resin for a toner comprising a vinyl resin (L) having a molecular weight of up to 50,000 and a crosslink vinyl resin (H) comprising a glycidyl crosslinking agent (A) for making a crosslinking copolymer units of styrene and acrylic having a molecular weight of up to 100,000 and a gel part of up to 50%. Polymer resin C is made from resins (L) and (H). The tested ratios of resins (L)/(H) are 97-93/3-7. However, a wider range of a ratio of resins (L)/(H) can be expected and/or possible to one having ordinary skill in the art at the time the invention was made. At least one additional resin D is also disclosed, taught and suggested to be incorporated in the toner. However, a wider range of the ratio of the vinyl resins can be expected and/or possible to be used one having ordinary skill in the art. Please see the whole disclosure of the applied reference, especially at least on paragraphs 0016 to 0024, 0029 to 0051, 0054, Examples. (*) The language "...obtained by...50%" and "(I)...(L)" is a product by process. Normally, the product-by-process has its value on product by itself, per se, until applicants convincingly show or provide evidence on an for the record for the patentability of the processing steps of making the product are always made (1) a distinct product for each of all possible applied crosslinking vinyl resins type (A) of Iwa et al on the record and (2) the distinct product-by-process is always provided an unusual or unexpected results over each of all possible applied crosslinking vinyl resins type (A) of Iwa et al on the record. (**) The language "a

gel portion...50%”, “...vinyl polymer (H)...1,000,000...per 1 kg...”, “...vinyl polymer (H)...1,000,000...per 1 kg...”, “...vinyl polymer (L)...50,000...per 1 kg...”, “...vinyl polymer (D)...50,000...per 1 kg...”, “crosslinking agent (A)...equivalent/100 g" or the like is a property or a measurement of a property of a material. For a patentability of a property of a measurement of a property of a material, it is allowed by law to request and require applicants to convincingly show or provide a distinct property or measurement of a property of the material on the record since (#) an allowed or patented claim would have no value when someone is reasonably shown to the same of obviously about the same property of measurement of the applied material using all possible combinations of the teachings and/or suggestions in the applied Iwa et al (##) arguments alone are not a factual evidence. A showing should be submitted in the next response to this application in order for it to be considered timely. In the absence of convincing evidence as clearly pointed out and set forth on the record, the above claims have insufficient reasons for their allowability and are reasonably rendered *prima facie* obvious by Iwa et al.

Applicant's arguments filed 07/01/08 have been fully considered but they are not persuasive.

Applicants urge that there is no additional resin D in the applied toners.

Please see at least Iwa et al on at least paragraph 0054.

Applicants rely on the showings under Rule 132 filed on 07/01/08 for the patentability of the claims. The showings are considered in the next paragraph.

II. The showings filed on 07/01/08 has been considered but have and are given a little to no value as compared to the broadly claimed embodiments.

(A) Since applicants rely on the results of the showings in Examples 1-16 in the instant application for the patentability of the claims. All aspects in the Examples 1-16 must be considered, read and limited to for the claims as relied on the patentability of the claims with respect to all chemical ingredients and their adjacent homologue, their amounts and reasonably and obviously about +/- 0.02% to one having ordinary skill in the art, all conditions and reasonably and obviously about +/- 0.02% of the same making and (testing or using such as each specific fixing temperature for each specific toners) conditions. One should look in to this issue since a benefit may be found and obtained.

(B) It would like to see tested results using:

- (1) about 5/95 ratio of vinyl polymer (H)/(L) as broadly disclosed and claimed,
- (2) about 0.1 moles of groups of OH, COOH, acid anhydride and amine per 1 kg of vinyl polymer (H) as broadly disclosed and claimed.
- (3) about 0.000 001 micro-moles of groups of OH, COOH, acid anhydride and amine per 1 kg of vinyl polymer (H) as broadly disclosed and claimed.
- (4) about 0. 000 000 001 micro-moles of a crosslinking agent per 1 kg of vinyl polymer (H) as broadly not disclosed but openly considered.

(5) about 80/20 ratio of resin C/ resin D as broadly disclosed.

(6) about 250/100 ratio of that of carbon black/binder resins as broadly disclosed.

(7) about 10/100 ratio of that of metal-containing azo dye charge control agent/binder resins as broadly disclosed.

None of the showings have been tested to any one of items from “(1)” to “(7)” above. Therefore, the showings are incomplete and are not commensurate in scope the broadly claim embodiments. Accordingly, the showings have and are given a little to no value as compared to the broadly claimed embodiments.

C. An allowed claim or patent would have no value when someone reasonably shows that:

(1) There is at least one of the applied toners having the same or obviously the same advantage to at least of the broadly claimed toner with items from “(1)” to “(7)” above.

(2) There is at least one of the broadly claimed toner with items from “(1)” to “(7)” above having less result than at least one result in examples 1-16 as relied on for the patentability of the claims. One should look in to this issue because a benefit may be found and obtained.

An showing that is not considered during the prosecution of this application must be firstly considered and taken before any other issue.

D. The showings of Iwa et al Examples 1-10 are improper since they do not contain resin D.

III. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Iwa et al (2002/0076637) considered in view of Masazumi et al (JP 09-244295) with its machine English language translation as provided by applicants).

Iwa et al disclose, teach and suggest a binder resin for a toner comprising a vinyl resin (L) having a molecular weight of up to 50,000 and a crosslink vinyl resin (H) comprising a glycidyl crosslinking agent (A) for making a crosslinking copolymer units of styrene and acrylic having a molecular weight of up to 100,000 and a gel part of up to 50%. Polymer resin C is made from resins (L) and (H). The tested ratios of resins (L)/(H) are 97-93/3-7. However, a wider range of a ratio of resins (L)/(H) can be expected and/or possible to one having ordinary skill in the art at the time the invention was made. At least one additional resin D is also disclosed, taught and suggested to be incorporated in the toner. However, a wider range of the ratio of the vinyl resins can be expected and/or possible to be used one having ordinary skill in the art. Please see the whole disclosure of the applied reference, especially at least on paragraphs 0016 to 0024, 0029 to 0051, 0054, Examples. (*) The language "...obtained by...50%" and "(I)...(L)" is a product by process. Normally, the product-by-process has its value on product by itself, per se, until applicants convincingly show or provide evidence on an for the record for the patentability of the processing steps of making the product are always made (1) a distinct product for each of all possible applied crosslinking vinyl resins type (A) of Iwa et al on the record and (2) the distinct product-by-process is always provided an unusual or unexpected results over each of all possible applied crosslinking vinyl resins type (A) of Iwa et al on the record. (**) The language "a gel portion...50%", "...vinyl polymer (H)...1,000,000...per 1 kg...", "...vinyl polymer (H)...1,000,000...per 1 kg...", "...vinyl polymer (L)...50,000...per 1 kg...", "...vinyl polymer (D)...50,000...per 1 kg...", "crosslinking agent (A)...equivalent/100 g" or the like is a property or a measurement of a property of a material. For a patentability of a property of a measurement of a property of a material, it is allowed by law to request and require applicants to convincingly show or provide a distinct property or measurement of a property of the material on the record since (#) an allowed or patented claim would have no value when someone is reasonably shown to the same of obviously about the same property of

measurement of the applied material using all possible combinations of the teachings and/or suggestions in the applied Iwa et al (##) arguments alone are not a factual evidence. A showing should be submitted in the next response to this application in order for it to be considered timely. In the absence of convincing evidence as clearly pointed out and set forth on the record, the above claims have insufficient reasons for their allowability and are reasonably rendered *prima facie* obvious by Iwa et al.

Iwa et al do not specify a wide ratio of the resins. However, it is known in the art to use and practice with a wide ratio of the resins to obtain a wise range of an image operation in the art. Evidence can be seen in Masazumi et al at least on paragraphs 0071 and 0075.

Since the above references are all related to resins for toners, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use or cite the wide range of resins for a reasonable expectation of obtaining a wide range of an image operation as disclosed, taught, suggested and obtained in Masazumi et al.

Applicant's arguments filed 07/01/08 have been fully considered but they are not persuasive.

“Furthermore, JP '295 discloses a resin composition for a toner. In JP '295, the resin composition is obtained by mixing a resin (A) with a resin (B), wherein the resin (A) is composed of a lower molecular weight component having a molecular weight of 3×10^3 to 5×10^4 , and a higher molecular weight component having a molecular weight of 3×10^5 to 5×10^6 , and wherein the resin (B) is composed of a vinyl polymer (b1) having a glycidyl group or a 13-methylglycidyl group, and a vinyl polymer (b2) other than the vinyl polymer (b1).”

The resin (A), the vinyl polymer (b1), and the vinyl polymer (b2) disclosed in JP '295 might correspond to the vinyl polymer (B), the crosslinking agent (A), and the vinyl polymer

(D) recited in present claim 1, respectively. However, in JP '295, the vinyl polymer (b2) is mixed with the resin (A) after being mixed with the vinyl polymer (b1). JP '295 fails to disclose a binder resin obtained by reacting the vinyl polymer (b1) with the vinyl polymer (A), then mixing thus obtained polymer with the vinyl polymer (b2). Therefore, JP '295 does not rectify the deficiencies of Iwa. Thus, even if JP '295 and Iwa are combined, the combination still would not result in the subject matter of claim 1. Claim 2 depends from claim 1."

The record shows that it is a misinterpretation of the rejection on the record that the applied Masazumi et al secondary reference is applied for the teachings and/or suggestions of the specific resins while the applied teachings and/or suggestions of the ratio of the resins on the record is not recognized.

IV. Claims 1 and 3-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fujikawa et al (2002/0098431).

Fujikawa et al disclose, teach and suggest a binder resin for a toner comprising a vinyl resin (L) having a molecular weight of up to 40,000 and a crosslink vinyl resin (H) comprising a glycidyl crosslinking agent (A) for making a crosslinking copolymer units of styrene and acrylic having a molecular weight of up to 100,000 and having from 0.1% by weight of insoluble matter. The tested ratios of vinyl resins (L)/(H) are about 80/20. However, a wider range of the ratio of the vinyl resins can be expected and/or possible to be used one having ordinary skill in the art. Polymer resin C is made from resins (L) and (H). At least one additional resin D is also disclosed, taught and suggested to be incorporated in the toner. The tested ratios of vinyl resins (C)/(D) are about 90-95/10-5. However, a wider range of the ratio of the vinyl resins can be expected and/or possible to be used one having ordinary skill in the art. Please see the whole disclosure of the applied reference, especially at least on paragraph 0063 to 0065, 0135 to 0140, 0156 to 0161, 0179 to 0181, Examples. (*) The language "...obtained by...50%" and "(I)...(L)" is a product by process. Normally, the product-by-process has its value on product by itself, per se, until applicants convincingly show or provide evidence on an for the record for the patentability of the processing steps of making the product are always made (1) a distinct product for each of all possible

applied crosslinking vinyl resins type (C) of Fujikawa et al on the record and (2) the distinct product-by-process is always provided an unusual or unexpected results over each of all possible applied crosslinking vinyl resins type (C) of Fujikawa et al on the record. (**) The language “a gel portion...50%”, “...vinyl polymer (H)...1,000,000...per 1 kg...”, “...vinyl polymer (H)...1,000,000...per 1 kg...”, “...vinyl polymer (L)...50,000...per 1 kg...”, “...vinyl polymer (D)...50,000...per 1 kg...”, “crosslinking agent (A)...equivalent/100 g” or the like is a property or a measurement of a property of a material. For a patentability of a property of a measurement of a property of a material, it is allowed by law to request and require applicants to convincingly show or provide a distinct property or measurement of a property of the material on the record since (#) an allowed or patented claim would have no value when someone is reasonably shown to the same of obviously about the same property of measurement of the applied material using all possible combinations of the teachings and/or suggestions in the applied Fujikawa et al (##) arguments alone are not a factual evidence. A showing should be submitted in the next response to this application in order for it to be considered timely. In the absence of convincing evidence as clearly pointed out and set forth on the record, the above claims have insufficient reasons for their allowability and are reasonably rendered *prima facie* obvious by Fujikawa et al.

Applicant's arguments filed 07/01/08 have been fully considered but they are not persuasive.

Applicants urge that there is no additional resin D in the applied toners. Please see at least Iwa et al on at least paragraphs 0041, 0054, 0180, 0181 and Examples.

V. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fujikawa et al (2002/0098431) considered in view of Masazumi et al (JP 09-244295) with its machine English language translation as provided by applicants).

Fujikawa et al disclose, teach and suggest a binder resin for a toner comprising a vinyl resin (L) having a molecular weight of up to 40,000 and a crosslink vinyl resin (H) comprising a glycidyl crosslinking agent (A) for making a crosslinking copolymer units of styrene and acrylic having a molecular weight of up to 100,000 and having from 0.1% by weight of insoluble matter. The tested ratios of vinyl resins (L)/(H) are about 80/20. However, a wider range of the ratio of the vinyl resins can be expected and/or possible to be used one having ordinary skill in the art. Polymer resin C is made from resins (L) and (H). At least one additional resin D is also disclosed, taught and suggested to be incorporated in the toner. The tested ratios of vinyl resins (C)/(D) are about 90-95/10-5. However, a wider range of the ratio of the vinyl resins can be expected and/or possible to be used one having ordinary skill in the art. Please see the whole disclosure of the applied reference, especially at least on paragraph 0063 to 0065, 0135 to 0140, 0156 to 0161, 0179 to 0181, Examples. (*) The language "...obtained by...50%" and "(I)...(L)" is a product by process. Normally, the product-by-process has its value on product by itself, per se, until applicants convincingly show or provide evidence on an for the record for the patentability of the processing steps of making the product are always made (1) a distinct product for each of all possible applied crosslinking vinyl resins type (C) of Fujikawa et al on the record and (2) the distinct product-by-process is always provided an unusual or unexpected results over each of all possible applied crosslinking vinyl resins type (C) of Fujikawa et al on the record. (**) The language "a gel portion...50%", "...vinyl polymer (H)...1,000,000...per 1 kg...", "...vinyl polymer (H)...1,000,000...per 1 kg...", "...vinyl polymer (L)...50,000...per 1 kg...", "...vinyl polymer (D)...50,000...per 1 kg...", "crosslinking agent (A)...equivalent/100 g" or the like is a property or a measurement of a property of a material. For a patentability of a property or a measurement of a property of a material, it is allowed by law to request and require applicants to convincingly show or provide a distinct property or measurement of a property of the material on the record since (#) an allowed or patented claim would have no value when someone is reasonably shown to the same of obviously about the same property of measurement of the applied material using all possible combinations of the teachings and/or suggestions in the applied Fujikawa et al (##) arguments alone are not a factual evidence. A showing should be submitted in the next response to this application in order for it to be considered timely. In the absence of convincing evidence as clearly pointed out and set forth on the record, the above claims have insufficient reasons for their allowability and are reasonably rendered *prima facie* obvious by Fujikawa et al.

Iwa et al do not specify a wide ratio of the resins. However, it is known in the art to use and practice with a wide ratio of the resins to obtain a wise range of an image operation in the art. Evidence can be seen in Masazumi et al at least on paragraphs 0071 and 0075.

Since the above references are all related to resins for toners, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use or cite the wide range of resins for a reasonable expectation of obtaining a wide range of an image operation as disclosed, taught, suggested and obtained in Masazumi et al.

Applicant's arguments filed 07/01/08 have been fully considered but they are not persuasive.

“Furthermore, JP '295 discloses a resin composition for a toner. In JP '295, the resin composition is obtained by mixing a resin (A) with a resin (B), wherein the resin (A) is composed of a lower molecular weight component having a molecular weight of 3×10^3 to 5×10^4 , and a higher molecular weight component having a molecular weight of 3×10^5 to 5×10^6 , and the resin (B) is composed of a vinyl polymer (b1) having a glycidyl group or a 13-methylglycidyl group, and a vinyl polymer (b2) other than the vinyl polymer (b1).

The resin (A), the vinyl polymer (b1), and the vinyl polymer (b2) disclosed in JP '295 might correspond to the vinyl polymer (B), the crosslinking agent (A), and the vinyl polymer (D) recited in present claim 1, respectively. However, in JP '295, the vinyl polymer (b2) is mixed with the resin (A) after being mixed with the vinyl polymer (b1). JP '295 fails to disclose a binder resin obtained by reacting the vinyl polymer (b1) with the vinyl polymer (A), then mixing thus obtained polymer with the vinyl polymer (b2). Therefore, JP '295 does not rectify the deficiencies of Fujikawa. Thus, even if JP '295 and Fujikawa are combined, the combination still would not result in the subject matter of claim 1. Claim 2 depends from claim 1.”

The record shows that it is a misinterpretation of the rejection on the record that the applied Masazumi et al secondary reference is applied for the teachings and/or suggestions of the specific resins while the applied teachings and/or suggestions of the ratio of the resins on the record is not recognized.

VI. The applied Masazumi et al (JP 09-244295) is withdrawn in the rejection of "Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Masazumi et al (JP 09-244295 with its machine English language translation as provided by applicants)" in view of the amendment and arguments.

VII. The applied Yasuo et al (JP 09-31914) is withdrawn in the rejection of "Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yasuo et al (JP 09-319140 with its machine English language translation as provided by applicants)" in view of arguments.

VIII. International Search Report shows that JP-61-163347 is pertinent to all of the instant claims. However, applicants submit its English language Abstract only. It is insufficient to formulate a rejection against any one of the claims. It is considered cumulate for now but will be next in line to be considered and/or

applied before any issue of an allowable claim is made. Applicants are requested to early, timely and candidly provide a pertinent portion or an English language equivalent of the reference on the record for an early consideration and allowance of the instant claims.

IX. Machine English translations of Anohito et al (JP 10-0878837), Takashi (JP 11-327210) and Kazuya et al (10-087837) submitted by applicants on 04/16/08 being acknowledged. Takashi (JP 11-327210) has teachings and/or suggestions as those in the applied secondary reference with respect Takashi (JP 11-327210) in the above applied rejections. It will be applied when Takashi is overcome. Kazuya et al (10-087837) have the teachings and/or suggestions as those in the above applied primary references with respect to Iwa et al (2002/0076637) and Fujikawa et al (2002/0098431). It will be applied when one or more of Iwa et al (2002/0076637) and Fujikawa et al (2002/0098431) are overcome.

X. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is

filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

XI. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hoa V. Le whose telephone number is 571-272-1332.

The examiner can normally be reached from 6:30 AM to 4:30 PM on Monday though Thursday and about the same time of most Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on 571-272-1526.

Applicants may file a paper by (1) fax with a central facsimile receiving number 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Hoa V. Le/

Primary Examiner, Art Unit 1795

082208